

### **REMARKS**

Applicants appreciate the Examiner's thorough examination of the present application as evidenced by the Office Action of January 24, 2006 (hereinafter "Office Action").

Applicants especially appreciate the indication that dependent Claims 8, 10, 13, 15, 19, 22, 25, 26 - 34, 53, 55, 58, 60, 64, 67, 70 - 79, 98, 100, 103, 105, 109, 112, and 115 - 124 recite patentable subject matter. Rather than write any of these allowable claims in independent form at this time, Applicants have amended independent Claims 1, 46, and 91 to incorporate the recitations of dependent Claims 2, 47, and 92, respectively. Dependent Claims 2, 47, and 92 have been canceled and various other dependent claims have been amended to correct their dependencies in light of the cancellation of dependent Claims 2, 47, and 92. Applicants respectfully submit that the cited references used to reject dependent Claims 2, 47, and 92 are not properly combinable under 35 U.S.C. §103(a). Accordingly, Applicants submit that all pending claims are in condition for allowance. Favorable reconsideration of all pending claims is respectfully requested for at least the reasons discussed hereafter.

#### **Claim Objections**

Claims 2, 47, and 92 stand objected to because of the use of the word comprising in connection with the at least one access network element. In response, Applicants have adopted the Examiner's suggestion in the amendments made to independent Claims 1, 46, and 91.

#### **Independent Claims 1, 46, and 91 are Patentable**

As discussed above, Applicants have amended independent Claims 1, 46, and 91 to incorporate the recitations of dependent Claims 2, 47, and 92, respectively. Dependent Claim 2 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent No. 6,748,433 to Yaakov (hereinafter "Yaakov") in view of U. S. Patent No. 6,405,250 to Lin et al. (hereinafter "Lin").

Independent Claim 1, as amended, is directed to a method of managing a service and has been reproduced below:

obtaining service quality requirements from a client;  
collecting quality data from a network that comprises a plurality of

network elements, comprising:  
    querying at least one access network element for the quality data, the at least one access network element is one of those network elements of the plurality of network elements that are configured at an edge of the network and provide access to the network;  
    saving the quality data in a repository;  
    analyzing the quality data; and  
    saving the analyzed quality data in the repository; and  
    comparing the collected quality data with the service quality requirements to determine if the service quality requirements are satisfied.

Independent Claims 46 and 91 include similar recitations. Thus, according to the recitations of the pending independent claims, at least one network element is queried for the quality data *and* the at least one network element is configured at an edge of the network and provides access to the network.

The Office Action acknowledges that "...Yaakov fails to teach querying the access network element for the quality data," but alleges that Lin provides the missing teaching. (Office Action page 4). Applicants respectfully submit, however, that neither Yaakov nor Lin includes any motivation or suggestion to modify Yaakov as indicated in the Office Action.

A determination under §103 that an invention would have been obvious to someone of ordinary skill in the art is a conclusion of law based on fact. *Panduit Corp. v. Dennison Mfg. Co.* 810 F.2d 1593, 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987), *cert. denied*, 107 S.Ct. 2187. After the involved facts are determined, the decision maker must then make the legal determination of whether the claimed invention as a whole would have been obvious to a person having ordinary skill in the art at the time the invention was unknown, and just before it was made. *Id.* at 1596. The United States Patent and Trademark Office (USPTO) has the initial burden under §103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

To establish a *prima facie* case of obviousness, the prior art reference or references when combined must teach or suggest *all* the recitations of the claims, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. M.P.E.P. §2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests

the desirability of the combination. M.P.E.P. §2143.01, citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). As emphasized by the Court of Appeals for the Federal Circuit, to support combining references, evidence of a suggestion, teaching, or motivation to combine must be **clear and particular**, and this requirement for clear and particular evidence is not met by broad and conclusory statements about the teachings of references. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). In another decision, the Court of Appeals for the Federal Circuit has stated that, to support combining or modifying references, there must be **particular** evidence from the prior art as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

As affirmed by the Court of Appeals for the Federal Circuit in *In re Sang-su Lee*, a factual question of motivation is material to patentability, **and cannot be resolved on subjective belief and unknown authority**. See *In re Sang-su Lee*, 277 F.3d 1338 (Fed. Cir. 2002). It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."

Yaakov describes the use of Remote Test Units 20 for obtaining quality data from the network edge at col. 7, lines 16 - 23 as follows:

To this purpose, at least two opposite access units 16 are provided with Remote Test Units (RTU) 20 for **intrusive** quality monitoring which are switched in the access lines and are capable of obtaining particular quality parameters from messages of a particular call transmitted there-between over the network (to be more exact, the parameters are determined by comparison transmitted signals to the received ones). (Emphasis Added)

Thus, according to Yaakov, Remote Test Units are inserted at the network edge to obtain quality data in an intrusive manner. Yaakov describes the use of non-intrusive Monitoring Systems (MS) 22 for collecting quality data; however, the non-intrusive Monitoring Systems 22 are not used as the network edge, but are instead used within the signaling/trunking network as shown in FIGS. 1 and 2. (Yaakov, col. 7, lines 24 - 30 and col. 7, line 66 - col. 8, line 2).

By contrast, Lin describes the collection of status information from a network

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element in a passive, non-intrusive manner. For example, Lin states:

In order for NMS 120 to gather status information from NE's 101-104, each NE must either report to NMS 120 voluntarily or response to a request from NMS 120; there is no way for NMS 120 to 'passively observe' the behavior of an NE without the cooperation of the NE. In other words, as part of its design, an NE must report a selected set of status information upon triggering of some internal or external events. (Lin, col. 7, lines 12 - 19).

Applicants respectfully submit that one skilled in the art would not be motivated to combine the intrusive data collection design of Yaakov with the passive, non-intrusive design of Lin as such a combination would appear to be duplicative in that both Yaakov's Remote Test Units 20 and the network elements on the network edge would be tasked with collecting quality data. Such an approach would involve increased expense due to the addition of the Remote Test Units 20 and increased complexity in determining what data is collected via the Remote Test Units 20 and what data is collected at the network elements on the network edge.

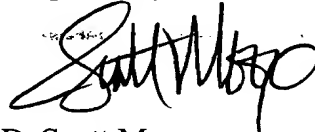
Accordingly, for at least the foregoing reasons, Applicants respectfully submit that independent Claims 1, 10, 23, 26, 35, 48, and 57 are patentable over the cited references and that Claims 3 - 9, 11 - 14, 16 - 22, 25, 28 - 34, 36 - 39, 41 - 47, 50 - 56, 58 - 61, 63 - 69 are patentable at least per the patentability of independent Claims 1, 10, 23, 26, 35, 48, and 57.

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### CONCLUSION

In light of the above amendments and remarks, Applicants respectfully submit that the above-entitled application is now in condition for allowance. Favorable reconsideration of this application, as amended, is respectfully requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (919) 854-1400.

Respectfully submitted,




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